28 Cont

8 becoming a customer of said third party.--

Claim 23, line 2, change "second entity" to --third party--.

Claim 25, line 1, delete "acquisition".

Cancel claim 27.

R E M A R K S

This paper is responsive to the Office Action dated August 2, 2000.

Claims 1-26 remain in this application, claim 27 having been cancelled in this paper. The pending claims stand rejected and are now presented for reconsideration in view of the foregoing amendments and the following remarks.

Claims 1-12, 14-20 and 22-26 were "rejected under 35 U.S.C. §112, second paragraph, as being indefinite" on account of the use of the term "acquisition offer" in those claims. It was the Examiner's position that the meaning accorded to the term "acquisition offer" was "repugnant to the usual meaning of that term".

To overcome this rejection, the term "acquisition offer" has been deleted from the rejected claims. Accordingly, this rejection under §112, second paragraph, should be withdrawn.

Claims 1-12, 14-20 and 22-26 were "rejected under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential steps". In explaining this rejection, the Examiner asserted that the omitted steps were "receiving acceptance of the offer from the customer" and "acquiring the customer by transferring the offer amount to the first entity by the second entity".

To overcome this rejection, claims 1, 11, 12, 14, 19, and 20 have been amended to include either the steps referred to by the Examiner or corresponding "means plus function" elements.

As to claim 22, it is believed that this rejection was applied in error. The Examiner's rationale for this rejection was premised on the appearance of the term "customer acquisition" in the preamble of the rejected claims. The Examiner reasoned that the referenced claim elements were needed in the claims to complete the concept of "customer acquisition". However, the term "customer acquisition" does not appear in the preamble of claim 22. Rather, claim 22 is directed to a "method for paying an amount due indicated on a billing statement ...". Thus there is no incompleteness of claim 22, and it is accordingly submitted that the rejection should be withdrawn in regard to claim 22.

Claims 1 and 11-13 were "rejected under 35 U.S.C. §103(a) as being unpatentable" over an asserted combination of the McNatt et al. and Linnen et al. references.

Claim 1, as now presented, is directed to a "computerized customer acquisition method" including steps of "selecting a customer account record from an electronic customer account database of a first entity", the customer account record "including a customer identifier", "determining if an individual indicated" by the customer identifier "is a customer of the second entity", "sending a billing statement" to the individual, "providing with the billing statement an offer" to the individual "to pay at least a portion of an amount due" on the billing statement if the individual "becomes a customer" of the second entity, "receiving acceptance" of the offer from the individual, and "acquiring the individual as a customer by transferring" the at least a portion of the amount to the first entity by the second entity."

The rejection of claim 1 relies on the practice referred to in the McNatt document of AT&T mailing checks on an unsolicited basis to prospective customers. If the customers sign or cash the checks, this signifies that they are switching their long distance service to AT&T.

Applicants note that this practice has nothing to do with sending a billing statement from a first entity to an individual, nor with providing an offer with the billing statement to that individual to pay at least a portion of an amount due on the billing statement if the individual becomes a customer of a second entity. The AT&T practice of distributing checks to prospective customers is merely a vehicle for providing a cash reward to customers who switch to AT&T service. There is nothing that one of ordinary skill in the art would infer from that practice that would lead to an offer to pay off an amount due on a billing statement to a first entity on the condition that the customer begins doing business with a second entity.

Moreover, the method of claim 1 provides the advantage that, because it is tied in with a billing statement, the targeted individual is more likely to respond to the offer than would be the case in "junk mail" type offerings such as the AT&T unsolicited checks. This is because individuals almost always open and read billing statements but often fail to open junk mail. Thus the method of claim 1 provides a degree of effectiveness that would not be provided by the AT&T practice described by the McNatt document.

The remarks made immediately above in regard to claim 1 are equally applicable to claims 11-13, which have been amended in a similar fashion to claim 1. Accordingly, it is submitted that the rejections of claims 1 and 11-13 should be reconsidered and withdrawn.

Claim 14 is directed to a "computerized customer acquisition method" including steps of "establishing in an electronic database predefined conditions for offering to pay an amount to an individual provided" the individual becomes a customer of a first entity, "providing" the predefined conditions "to a second entity to determine whether"

the second entity should provide to the individual "an offer to pay at least a portion of an amount due on a billing statement" for the individual, "receiving acceptance" of the offer from the individual and "acquiring the customer by transferring the offer amount to the second entity by the first entity".

In explaining the rejection of claim 14, the Examiner stated that "it is well known for the first entity to insert third party offers into its billing statements". From this Examiner concluded that "it is also obvious that in order to do this, the second entity must provide the first entity with a list of customers whom the second entity has selected to receive the offer".

Applicants respectfully challenge this assertion and, to the extent that it is based on the taking of Official Notice, applicants request that the Examiner provide a citation to a prior art reference to support this statement. Moreover, applicants note that if a first entity is inserting third party offers in the billing statements sent out by the first entity, there is no requirement that the second entity provide to the first entity a list of customers who are to receive such offers. For example, it is believed that in the most common case the first entity could simply insert third party offers in all of its billing statements. Alternatively, the first entity could select on the basis of criteria of its own choosing which billing statements are to receive the third party offers. There simply is no logical basis for concluding that the practice of including third party offers in a billing statement requires that the third party ("second entity") provide the issuer of the billing statement with a list of customers who are to receive the offer. Rather, it is believed that the Examiner's conclusion in this regard reflects teachings of the present application, and particularly the invention of claim 14, in which the party which is to provide the offers to pay an amount due on a billing statement ("second entity" in claim 14) is provided with predetermined conditions by the billing entity ("first entity") for the purpose of determining which individuals are to receive offers. This feature is not suggested in the least by the AT&T check promotion practice described in McNatt and also is not suggested by the teaching of Jermyn.

It is noted that in Jermyn the purchases of customers at supermarkets are tracked and their purchase history developed to allow a distributor of coupons by mail to target mailings of coupons based on recipients' purchase history. Like the AT&T practice of McNatt, Jermyn's targeted coupon system has nothing to do with selecting individuals to receive offers from an entity to pay off a billing statement rendered to the individual from another entity.

Accordingly, it is submitted that the rejection of claim 14 should be reconsidered and withdrawn. Such is also the case for claims 19-21 which are parallel to claim 14.

Claim 22 is directed to a "method for paying an amount due indicated on a billing statement generated from an electronic database", including steps of "receiving an offer with the billing statement to have at least a portion" of the amount due "paid by a third party in exchange for becoming a customer" of the third party, "indicating acceptance" of the offer for the third party to pay at least a portion of the amount due, and "becoming a customer" of the third party.

In discussing the rejection of claim 22, the Examiner purported to take "Official Notice ... that it is old and well known within the marketing arts to offer to pay off or reduce one or more of the prospective customer's bills if the individual becomes a customer". As examples the Examiner cited first the practice of car dealers of offering to pay off an amount due on the customer's present automobile if the customer buys a car from the dealer and secondly that credit card issuers will pay off a balance owed to a competing credit card if the individual switches to the issuer's card. The Examiner then concluded that it would have been obvious that "AT&T could offer to pay some or all of the individual's phone bill if the individual switched their long distance carrier to AT&T". Although applicants acknowledge that it is known for car dealers to pay off loans on cars traded in, or for credit issuers to take over balances on a new customer's other credit cards, it does not follow that a practice of paying a prospective customer's bills can be generalized from these two examples. To the extent that the

Examiner wishes to rely on the general statement about paying off or reducing one or more of a prospective customer's bills, this statement is challenged and the Examiner is requested, pursuant to M.P.E.P §2144.03, to cite a prior art reference to support this alleged general practice.

Furthermore, the two examples of taking over a car loan balance or a credit card balance would not make it obvious for a company like AT&T to alter its practice of sending out checks to prospective customers so as to substitute for such checks paying off a local phone company bill. It is at this point that the insidious practice of hindsight has entered in such that the Examiner is using the teachings of the present invention to generalize from the credit card and car loan examples and then to design a particular promotion that is based on the teachings of the present application and is not supported by the car loan and credit card balance practices.

There is nothing in the car loan or credit card balance practices that would lead to sending with the billing statement of a first party an offer from a second party to pay off the amount due (or a portion thereof) under the billing statement. The AT&T checks sent to induce the recipient to switch long distance services are quite a different practice, from which the invention as recited in claim 22 cannot be inferred.

It is accordingly submitted that the rejection of claim 22 should be reconsidered and withdrawn.

It is believed that the above discussion accounts for all of the pending independent claims. The other claims, being dependent, are submitted as patentable on the basis of their respective parent claims.

Allowance of all claims and passage to issue are respectfully requested.

The Examiner is kindly invited to contact Nathaniel Levin at telephone number (203) 461-7114 or through electronic mail at nlevin@walkerdigital.com with any questions or comments regarding the present application.

Please charge any additional fees that may be required for this Amendment, or credit any overpayment to Deposit Account No. 50-0271.

Respectfully submitted,

9/7/00
Date

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